

## **REMARKS**

### **I. Introduction**

The application has been carefully reviewed in light of the Office Action dated February 25, 2008. This communication is believed to be a timely and complete response to that Office Action. Claims 1-33 (previously numbered 1-27, 29, 30, 30-33; currently numbered 1-33) were pending in the present application. By the present Office Action, claims 1-33 have been rejected.

By the present response, certain of the claims have been amended merely to correct a numbering error, new claims 34-49 have been added, and upon entry of the present response claims 1-49 are present. Reconsideration and reexamination of the present application is respectfully requested in view of the following remarks, which establish that the pending claims are directed to allowable subject matter.

### **II. SUMMARY OF THE AMENDMENTS**

#### ***In the Claims***

The claims were previously numbered 1-27, 29, 30, 30-33 with a missing claim number 28 and two claims numbered 30. The amendments to the claims that were pending in the present application were merely to correct the numbering of the claims and were not in response to any of the rejections presented by the Examiner. Claims 34-49 have been added.

### III. CLAIM REJECTIONS

#### ***Under 35 U.S.C. § 102***

The Examiner has rejected claims 1-33 (as previously numbered) under 35 U.S.C. § 102(b) or 102(e) as being anticipated by each of U.S. Patent No. 6,641,031 to Evans et al. (**Evans**), U.S. Patent No. 7,325,689 to Buss (**Buss**), U.S. Patent No. 6,230,893 to Karow (**Karow**), U.S. Patent No. 6,047,829 to Johnstone et al. (**Johnstone**), U.S. Patent No. 5,244,091 to Tannenbaum (**Tannenbaum**), U.S. Patent No. 4,817,819 to Kelly (**Kelly**), and U.S. Patent No. 4,192,422 to Kotyuk (**Kotyuk**). Applicant respectfully traverses this rejection and requests reconsideration and withdrawal thereof. For at least the reasons cited below, the Office Action fails to establish a prima facie case of anticipation under 35 U.S.C. § 102 and claims 1-34 (as currently numbered) are patentable over the cited art.

#### ***Buss is not available as a reference under 35 U.S.C. § 102(b) or 102(e)***

***Buss*** has a filing date that is after the priority date of the application.

#### **Legal Standard**

The burden is on the Patent Office to establish a prima facie case of anticipation.<sup>1</sup> The legal standard of anticipation has been settled by a large body of common law over the last century. A prima facie case of “[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.”<sup>2</sup> It is not enough for each word or element to appear in a single prior art reference, rather, “[a]nticipation requires...[t]hat the single prior art reference

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<sup>1</sup> *In re Skinner*, 2 U.S.P.Q.2d 1788, 1788-89 (B.P.A.I. 1986).

<sup>2</sup> *W. L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983).

disclose]...each and every element of the claimed invention, arranged as in the claim [at issue].<sup>3</sup>

Aside from the single prior art reference disclosing each and every element, arranged as in the claims at issue, courts also have noted that "there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in [the art]."<sup>4</sup> Even principles upon which the claimed invention operates must be consistent, since "[a] device [that] does not operate on the same principle [as the claimed device] cannot be an anticipation."<sup>5</sup>

Furthermore, the law of anticipation does not allow speculation, substitution, and/or rework. For example, "[i]t is not sufficient to constitute anticipation that the devices relied upon *might*, by a process of modification, reorganization, or combination with each other, be made to accomplish the function performed by the [claimed] device."<sup>6</sup>

If a reference does not explicitly set forth each and every element of the claim(s) at issue, inherency can be relied upon to demonstrate these elements. However, with respect to inherency, the CCPA has noted that "[i]nherency [is not] established by probabilities or possibilities. There mere fact that a certain thing *may* result from a

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<sup>3</sup> *Id.* 220 U.S.P.Q. at 313 (emphasis added).

<sup>4</sup> *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991).

<sup>5</sup> *Los Alamitos Sugar Co. v. Carroll*, 173 F. 280, 284 (9th Cir. 1909).

<sup>6</sup> *Id.* at 285 (emphasis added).

given set of circumstances is not sufficient[, rather, the element or function *must* necessarily result from the prior art reference.]<sup>7</sup>

Finally, mere disclosure of the claimed features is not necessarily sufficient. Rather, the cited reference must also teach the claimed invention in an enabling manner.<sup>8</sup> This requirement is consistent with the requirement that each and every element exist in the cited reference without making any modifications to the reference.

A *prima facie* case of anticipation, therefore, requires that 1) the Patent Office establish<sup>9</sup> that 2) a single prior art reference<sup>10</sup> 3) teaches in an enabling manner<sup>11</sup> 4) each of the claimed elements as arranged in the claims<sup>12</sup> 5) expressly or inherently<sup>13</sup> 6) as interpreted by one of ordinary skill in the art.<sup>14</sup> As a matter of law, none of requirements 1-6 have been demonstrated, a *prima facie* case of anticipation has not been established, and claims 1-33 are patentable over the cited art.

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<sup>7</sup> *In re Oelrich*, 666 F.2d 578, 581 (C.C.P.A. 1981)(quoting *Hansgirg v. Kemmer*, 102 F.2d 212, 214 (C.C.P.A. 1939))(emphasis added).

<sup>8</sup> *Akzo N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986).

<sup>9</sup> FN 1, *supra*.

<sup>10</sup> FN 2, *supra*.

<sup>11</sup> FN 7, *supra*.

<sup>12</sup> FN 3, *supra*.

<sup>13</sup> *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

<sup>14</sup> FN 4, *supra*.

***Under 35 U.S.C. § 103***

The Examiner has rejected claims 1-33 (as previously numbered) under 35 U.S.C. § 103(a) as obvious over each of U.S. Patent No. 6,641,031 to Evans et al. (*Evans*), U.S. Patent No. 7,325,689 to Buss (*Buss*), U.S. Patent No. 6,230,893 to Karow (*Karow*), U.S. Patent No. 6,047,829 to Johnstone et al. (*Johnstone*), U.S. Patent No. 5,244,091 to Tannenbaum (*Tannenbaum*), U.S. Patent No. 4,817,819 to Kelly (*Kelly*), and U.S. Patent No. 4,192,422 to Kotyuk (*Kotyuk*). Applicant respectfully traverses this rejection and requests reconsideration and withdrawal thereof. For the reasons cited below, the Office Action has failed to establish a *prima facie* case of obviousness, and the rejections must therefore be withdrawn. *M.P.E.P.* § 2142 (8th ed. Rev. 6, September, 2007).

***Buss is not available as a reference under 35 U.S.C. § 103(a)***

As established above, *Buss* is not available as a reference under 35 U.S.C. § 102(b) or 102(e). Further, *Buss* is not available as a reference under 35 U.S.C. § 103(a).

***There is No Support in the Record***

When arguing hypothetically combining or modifying the references, the Office Action states that "in the event any of the noted prior art is later deemed to be missing an element or feature, and that element or feature is conventional in the relevant art, it would have been obvious to provide the appropriate reference with the missing feature in order to improve its performance."<sup>15</sup> This statement is completely unsupported by the record.

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<sup>15</sup> Page 2 of the Office Action.

The mere statement that a proposed combination "would have been obvious," without any support from the record or any of the references, is insufficient to maintain a rejection under 35 U.S.C. § 103. *Ex parte Levingood*, 28 U.S.P.Q.2d 1300 (B.P.A.I. 1993)(holding that "rejections on obviousness cannot be sustained by mere conclusory statements..."); *M.P.E.P.* § 2143.01. As no evidence is provided for any motivation or need to combine the cited references, the rejections under 35 U.S.C. § 103 should be withdrawn.

**No Clear Articulation of Any Reason/Motivation to Combine**

A hypothetical combination or modification fails since there would be no motivation to combine or modify the cited references. The Office Action provides no support, and certainly no "clear articulation of [any] reason" that one of "ordinary skill in the art" would be motivated to combine or modify any of the cited references. *KSR International Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385, 1396 (2007)(citing *In re Kahn* 441 F.3d 977, 988 (Fed. Cir. 2006))(holding that there must be a clear articulation of the reasons why a claimed invention would be obvious; merely combining references is insufficient).

**Each and Every Element Must be Taught**

None of the applied references, either individually, or in any hypothetical combination with one another, teaches each feature of the amended claims. According to existing case law regarding rejections under 103, it is noted that each and every

element of the claims must be taught or suggested by the applied references, individually, or in combination, without the benefit of impermissible hindsight. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, each and every word of the claims at issue must be considered when judging the patentability of the claim at issue against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); M.P.E.P. § 2143.03. In short, none of the claim language can be ignored by the Office.

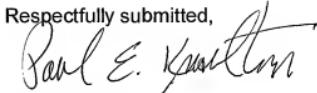
As a matter of law, a prima facie case of obviousness has not been established and claims 1-33 are patentable over the prior art.

#### IV. CONCLUSION

For at least the above reasons, Applicant respectfully requests allowance of the claims pending in this case and issuance of a patent containing these claims in due course. Should Examiner Ackun believe that a telephone conference would be useful to resolve any concerns and move this application to allowance, Examiner Ackun is respectfully requested to contact the undersigned at the telephone number listed below. Otherwise, Applicant respectfully requests timely issuance of a Notice of Allowance for the present application.

The present Response is considered to be timely filed as May 25<sup>th</sup>, 2008 is a Sunday and Monday, May 26<sup>th</sup> is Memorial Day. Included with the filing of this Response is \$1220.00 in excess claims fees (16 additional claims including 2 dependent claims). The Applicant believes this fee to be accurate however, any overpayment or underpayment may be charged to deposit account 50-3447. If a fee is required for an extension of time under CFR § 1.136 that is not accounted for above, such an extension is requested and the fee should also be charge to the Deposit Account.

Respectfully submitted,



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